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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,953	10/11/2001	Jan Byrla	225/50478	5831

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EXAMINER	
ESTREMSKY, GARY WAYNE	
ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/973,953	Byrla
Examiner	**Art Unit**
Estremsky	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Nov 15, 2002*

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-29* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claim 28, it is not clear if or how the limitation further defines the claimed method whereby the scope of the claim is rendered indefinite. The limitation appears tofurther define strucutre, not a step in the claimed process.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. As best understood, claims 1, 13, 19, 25, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,445,326 to Ferro.

Ferro '326 teaches Applicant's claim limitations including : a "passenger car" - as described in the abstract, having an "unlocking handle" - 36, "having a luminous construction" - see col 6, lines 1-4, where the luminous coating of the reference reads on broad limitation of "luminous body".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,445,326 to Ferro.

Ferro '326 does not explicitly disclose the luminescent coating to consist of a "luminescent crystal mixture which is mixed with a transparent plastic material and/or is embedded therein". However, the examiner takes Official Notice that luminescent coatings such as acrylic paint or

other clear plastic-base paint mixed with a luminescent crystal mixture are well known and within the scope Ferro '326 reference whereby it would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to provide a well known luminescent acrylic paint or other luminescent plastic coating where such construction would not affect the function of the disclosed device and one of ordinary skill in the art would have more than a reasonable expectation of success. The examiner points out that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,445,326 to Ferro in view of U.S. Pat. No. 5,129,694 to Tanimoto.

Although Ferro '326 does not disclose gluing the luminescent coating to the handle. Tanimoto '694 discloses that it is well known to glue a softer material portion of the desired color onto a handle base portion in order to provide a strong handle with the desired color. It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to provide the handle of Ferro '326 with a separate luminescent coating portion glued onto the base portion in order to provide a softer feel to the contact portion and allow a desired (luminescent) color to be used.

9. As best understood, claims 1, 2, 5, 6, 9, 10, 12-14, 16-20, and 22-29 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of U.S. Pat. No. 1,762,447 to Lowes.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Bingle '131 teaches Applicant's claim limitations including : a "passenger car" - see abstract, having an "unlocking handle" - 12. Bingle '131 teaches a luminescent handle at col 7, line 11-14 but does not teach a distinct "basic body" and "luminous body mounted thereon". However such handles are long known in the art as taught by Lowes '447 whereby it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a luminous handle for the device of Bingle '131 constructed from a basic body with a luminous body mounted thereon as taught by Lowes '447 in order to provide a handle made from a stronger material that is easy to locate in darkness due to its luminescence.

As regards claim 2, the handle construction of Lowes '447, as relied upon, reads on limitation of "dovetail guide" as shown in Fig 3 of that reference.

As regards claims 5, 6, Lowes '447, as relied upon does not explicitly disclose the luminescent coating to consist of a "luminescent crystal mixture which is mixed with a transparent plastic material and/or is embedded therein". However, the examiner takes Official Notice that luminescent coatings such as acrylic paint or other clear plastic-base paint mixed with a

luminescent crystal mixture are well known and within the scope of Lowes '447, as relied upon, whereby it would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to provide a well known luminescent acrylic paint or other luminescent plastic coating where such construction would not affect the function of the device and one of ordinary skill in the art would have more than a reasonable expectation of success.

As regards claim 26, although Lowes '447, as relied upon, does not disclose step of gluing, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide glue where the examiner takes Official Notice that it is well known in the art to provide glue in addition to or as an alternative to mechanical connection means to form a permanent connection and the use of glue would not otherwise affect the function of the invention and amounts to little more than an obvious design choice or engineering expedient. See U.S. Pat. No. 5,129,694 for example which discloses equivalent connection means of special-colored handle surface portion to handle base portion including gluing. The reference is cited herein to indicate general background knowledge of those having ordinary skill in the art.

10. Claims 3, 4, 7, 8, 11, 15, and 21 are rejected under 35 U.S.C.103 as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of U.S. Pat. No. 1,762,447 to Lowes and further in view of U.S. Pat. No. 5,088,781 to Ono.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Bingle '131 teaches Applicant's claim limitations including : a "passenger car" - see abstract, having an "unlocking handle" - 12. Bingle '131 teaches a luminescent handle at col 7. line 11-14 but does not teach a distinct "basic body" and "luminous body mounted thereon". However, Lowes '447 teaches that it is well known in the art to attach a separate luminescent handle portion to a base handle portion. Regardless, Lowes '447 does not teach a attaching the second portion to the base using a detent connection. However, it is well known in the art to attach the second portion to the base portion using a detent connection as shown by Ono '781 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to attach a separate luminescent portion to a handle base portion of Bingle '131 in order to form a strong handle with a luminescent portion.

Response to Arguments

11. Applicant's arguments have been fully considered but they are not persuasive.

Applicant's arguments against the 102 rejection in view Ferro '326 rest on the assumption that the 'luminous coating' of the reference is not a "luminous body".

Contrary thereto, it is the examiner's position that limitation of "body" is broad. It is not disclosed, claimed, or even argued that the "body" of the claimed invention has any physical

characteristic not possessed by the 'coating' of the reference. Applicant's argument is the conclusion, ie, that a luminous coating cannot define a luminous body.

The examiner recognizes that the coating may (or may not) have had a less than rigid state prior to its application on the handle and at that time, relied upon the underlying handle to give it 'body'. However, the finished product disclosed by the prior art has a luminous coating which defines a luminous body mounted on the handle as claimed. It is the examiner's position that the coating of the reference inherently has a real shape in any sense of the word and produces light and thereby reads on the broad limitation.

Inasmuch as Applicant seeks right to exclude others from making and using the claimed product, it seems reasonable to expect that broadest reasonable interpretation of the claim does not include that which is old and well known in the art. Furthermore, it has been held that claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974). The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference. i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

As regards luminescent acrylic paint being a known material, the examiner has made several U.S. Patents of record below in response to Applicant's request for prior art to illustrate

the subject for which Official Notice was taken in the previous Office Action. Each of these patents disclose that luminescent acrylic paint is old and well known. One of ordinary skill in the art of making luminescent handles would consider looking towards the luminescent coatings art and other known luminescent coatings when it is explicitly stated in the reference that the handle can be made luminescent by coating it with a luminescent coating. Once motivated by such teaching or suggestion, one of ordinary skill in the art would not restrict their coatings' search to the handle art for example and the only real question is whether or not luminous coatings as now claimed have been disclosed to the public. The prior art indicates that is the case. Inasmuch as acrylic paint forms a plastic coating, the prior art teaches claim limitations related thereto.

As regards 103 rejection in view of the Ferro '326 and Tanimoto '694 patents. Applicant's attention is directed to a closer review of the body of the rejection accompanying that rejection. Applicant's arguments are against the references individually and not toward the proposed modification of the structure of the base reference, or 'combination' of prior art teachings proposed by the examiner. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Similar consideration applies to arguments against 103 rejections in view of the Bingle '131 and Lowes '447 patents.

It is suggested that the patents relied upon as grounds of rejection, and the balance of the cited patents be carefully reviewed to better determine what elements are known in the art and

what combinations of elements are known and/or suggested by the art. For example, the Ferro '326 reference fully teaches providing an escape handle on a trunk latch with luminous portion to aid in escape as does the Bingle '131 patent. While the inventive disclosures of these two patents for example may not have been directly concerned with particular details of the actual construction of the handle, other references in that area fully teach that it is old and well known to manufacture luminescent handles for motor vehicles by forming them from more than one portion and combining the portions to form a composite handle having the desired strength, color and tactile characteristics.

It is the examiner's position that one of ordinary skill in the art would be motivated to take advantage of known technologies such as known composite handle structures and known luminescent materials in constructing a luminescent trunk release handle in accordance with teachings of the prior art.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in that Patents detailing how to make luminescent crystals, coatings, acrylic paints, composite door handles, and glowing trunk release handles are disclosed.

a. U.S. Pat. No. 1,263,880 to Glossop.

b. U.S. Pat. No. 3,706,673 to Wainer.

c. U.S. Pat. No. 3,767,459 to Kingsley.

d. U.S. Pat. No. 3,829,556 to Logan.

e. U.S. Pat. No. 3,872,222 to Barnes.

f. U.S. Pat. No. 4,318,001 to Degenhardt.

g. U.S. Pat. No. 4,724,327 to Mitchell.

h. U.S. Pat. No. 5,276,075 to Santini.

i. U.S. Pat. No. 5,469,758 to Howie.

j. U.S. Pat. No. 6,018,292 to Penny.

k. U.S. Pat. No. 6,139,394 to Maxim.

l. U.S. Pat. No. 6,242,064 to Howie.

m. U.S. Pat. No. 6,349,450 to Koops.

n. U.S. Pat. No. 6,349,984 to Marazzo.

o. U.S. Pat. No. 6,349,511 to Lam.

p. U.S. Pat. No. 6,369,395 to Roessler.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

a shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or

- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ___ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

_____

_____

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.

- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

January 27, 2003

GARY ESTREMSKY
PRIMARY EXAMINER